

**REMARKS/ ARGUMENTS**

Claims 14 to 19 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 14 to 19 were rejected under 35 U.S.C. 103(a) as being unpatentable over USP T644006 to Couling or USP 6467527 to Kubota et al.

Claims 14 to 19 have been amended. Claims 20 to 22 have been canceled without prejudice.

Reconsideration of the application based on the following remarks is respectfully requested.

**Rejections under 35 U.S.C. 112, second paragraph**

Claims 14 to 19 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 14 to 19 have been amended for clarity and applicants apologize for any confusion. The claims are now respectfully submitted as being clear and definite.

**Rejections under 35 U.S.C. 103(a)**

Claims 14 to 19 were rejected under 35 U.S.C. 103(a) as being unpatentable over USP T644006 to Couling or USP 6467527 to Kubota et al.

Couling discloses a magnesium base alloy suitable for use in high pressure die casting containing by weight from about 0.2 to about 3 percent aluminum, greater than 1.5 up to about 2 percent silicon and optionally up to about 2 percent manganese and up to about 1 percent zinc.

Kubota et al. discloses a method for die-casting a magnesium alloy comprises the step of casting a die cast product free of any hot tearing, shrinkage tearing and shrinkage cavity starting from a magnesium alloy comprising i) 1 to 10% by weight of aluminum; ii) at least one member selected from the group consisting of 0.2 to 5% by weight of a rare earth metal, 0.02 to 5% by weight of calcium and 0.2 to 10% by weight of silicon; and iii) not more than 1.5% by weight of manganese, and the balance of magnesium and inevitable impurities, using a cold chamber type die-casting machine. (Abstract).

Claim 14, as amended recites a water quenched die casting alloy, comprising:

Mg base;

Al between 2.8 and 3% by weight;

Si between 0.7, and 1.5 % by weight;

Mn greater than 0.20 % by weight;

Zn less than 0.20 % by weight;

Cu less than 100 ppm;

Ni less than 20 ppm; and

Fe less than 50 ppm.

It is respectfully submitted that neither Couling nor Kubota et al. discloses water quenched magnesium/aluminum die casting alloy. It is respectfully submitted that, contrary to the assertion on page 3 of the Office Action, Kubota et al. does not disclose an alloy that is water quenched and does not in any way discuss water quenching. The process of injecting a molten magnesium alloy having a temperature of 650 to 750 degrees C in a cold mold having a temperature of 150 to 350 degrees C as disclosed in Kubota et al. is in no way water quenching, but is simply the process of cold chamber type die-casting. Water quenching, as known to one of ordinary skill in the art, is a distinct process from simply die-casting.

Furthermore, "water quenched," as recited in claim 14, limits the device as recited in claim 14 because a water quenched alloy has distinctive structural characteristics compared to other alloys. (See MPEP 2113). Such characteristics are discussed in the present application, for example, at paragraphs [0013] and [0014].

Additionally, the documents presented herewith in the Declaration pursuant to 37 C.F.R. § 1.132 provide further support that water quenching imparts distinctive structural characteristics to the alloy recited in claim 14. The microstructures of magnesium-based alloy gear boxes formed using the conventional method of air cooling are shown on page 6 of the "Mg-Application in the 7G-Tronic-Gear" before and after 2000 hours of thermal aging and the microstructures of magnesium-based alloy gear boxes formed by water quenching according to the present invention are shown on page 7 of the "Mg-Application in the 7G-Tronic-Gear" before and after 2000 hours of thermal aging. (See also "Proceedings: 61<sup>st</sup> Annual World Magnesium Conference," pages 82, 83). The water quenched magnesium-based alloy gear

boxes include fine  $Mg_{17}Al_{12}$  phases after 2000 hours of thermal aging while the air cooled magnesium-based alloy gear boxes include coarse  $Mg_{17}Al_{12}$  phases after 2000 hours of thermal aging. Thus, the water quenching imparted distinctive structural characteristics to the magnesium-based alloy gear boxes.

It is respectfully submitted that it would not have been obvious to one of ordinary skill in the art to have water quenched the magnesium based alloys of Couling or Kubota et al., because handling hot magnesium, especially magnesium melts near water, is highly risky. Because magnesium is highly inflammable when hot or melted, one of skill in the art would have been led, at the time of the present invention, away from water quenching a magnesium based alloy.

It is also respectfully submitted that neither Couling nor Kubota et al. discloses “Zn less than 0.20 % by weight; Cu less than 100 ppm; Ni less than 20 ppm; and Fe less than 50 ppm,” as recited in claim 1. Kubota et al. discloses a balance of inevitable impurities (Abstract), but there is no indication that alloys disclosed in Kubota et al. include Zn, Cu, Ni and Fe below the levels recited in claim 1. Also, there is no indication that the alloy in Couling includes Zn, Cu, Ni and Fe below the levels recited in claim 1.

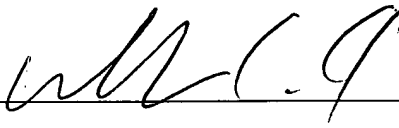
Withdrawal of the rejections under 35 U.S.C. 103(a) to claims 14 to 19 is respectfully requested.

With further respect to claim 18, it is respectfully submitted that neither Couling nor Kubota et al. discloses “the die casting alloy is a  $MgAl_3Si_1$  alloy,” as recited in claim 18, nor does the Office Action address this limitation.

**CONCLUSION**

The present application is respectfully submitted as being in condition for allowance and applicants respectfully request such action.

Respectfully submitted,  
DAVIDSON, DAVIDSON & KAPPEL, LLC

By:   
William C. Gehris  
Reg. No. 38,156

Davidson, Davidson & Kappel, LLC  
485 Seventh Avenue  
New York, New York 10018  
(212) 736-1940